



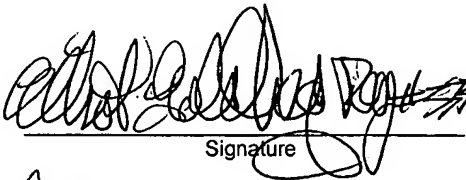

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		0879-0366P	
	Application Number	Filed	
	10/020,240-Conf. #8756	December 18, 2001	
	First Named Inventor Hiroshi TANAKA et al.		
	Art Unit	Examiner	
	2645	R. G. Foster	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>40,439</u></p> <p> Signature</p> <p> D. Richard Anderson Typed or printed name</p> <p><u>(703) 205-8000</u> Telephone number</p> <p><u>November 21, 2005</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Docket No.: 0879-0366P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hiroshi TANAKA et al.

Application No.: 10/020,240

Confirmation No.: 8756

Filed: December 18, 2001

Art Unit: 2645

For: COMMUNICATION TERMINAL RECEIVING
CONNECTION INFORMATION FROM A
CELLULAR PHONE AND
COMMUNICATION SYSTEM INCLUDING
SUCH A COMMUNICATION TERMINAL

Examiner: R. G. Foster

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. A Petition for a two-months extension of time is included.

This Request is being filed concurrently with a Notice of Appeal.

The Review is being requested for the reasons set forth on the attached three (3) sheets.

The Examiner has failed to establish a *prima facie* case of obviousness regarding the rejection of claims 1, 4-7, 9, and 14-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,943,603 to Parulski, et al. (Parulski). In explaining the reference to Parulski, the Examiner recognizes that in Figures 7-9 there is a combined cellular telephone/digital camera which is different from what is claimed in base claim 1, wherein the communication terminal is separate from the cellular phone and is locally positioned relative to the cellular phone when receiving the connection information (when receiving the menu of destinations) of claim 7. Recognizing that Figures 7-9 do not disclose the communication terminal separate from the cellular phone, the Examiner relies on Figures 1-3, which does show a camera 10 separate from element 12, a computer display. Thus, from this teaching in Figures 1-3, the Examiner asserts that one skilled in the art viewing the reference would make the communication terminal separate from the cellular telephone. While the Examiner refers to column 4, line 12, that the frequency system including a cellular system, this does not disclose or suggest that the cellular phone be separate from the communication terminal. The Examiner, in the Advisory Action, refers to MPEP § 2144.04 (V.c.). While this section of the MPEP does provide a case in which the Examiner apparently is relying on, as the facts in that case are completely different from the facts here, the legal precedent of that case does not apply. See MPEP § 2144.04, which explains this position.

Furthermore, the Examiner states that: "It would have been facially [sic] obvious to one of ordinary skill in the art, upon inspecting single patent containing two embodiments, to have desirable features of one embodiment into the other embodiment because both embodiments would have disclosed in the same docket as one of ordinary skill inspected the document." But, the statement is truly speculation, which is not competent evidence.

Furthermore, even if there was a *prima facie* case of obviousness established, which there is not, the Examiner has failed to consider the unexpected results achieved by the claims. That is more importantly what the Examiner has failed to consider is the unexpected results achieved by the combination. These unexpected results are set forth, for example, starting on page 2 of the specification. For example, the combination has cured the inconvenience previously present in

the prior art. Before jumping at a conclusion of obviousness, the Examiner must consider the results achieved. See *The Gillette Co. v S.C. Johnson & Son, Inc.* 16 USPQ 2d. 1923 (Fed.Cir. 1990) wherein the Court stated as follows:

"An analysis of obviousness of a claim combination must include consideration of the results achieved by the combination. As we explained in *Interconnect Planning Corp. v. Feil*, 774 Fed. 2d 1132, 1143, 227 USPQ 543, 551 (Fed.Cir. 1985) [cited in the MPEP]."

It is quite clear that the Examiner has failed to give consideration to the unexpected results, which must be considered as mandated by the Courts.

The comments set forth above also apply to independent claim 7.

With respect to the dependent claims, these claims are considered patentable at least for the same reasons as their base or intervening claims.

In rejecting claims 3 and 8, in the Final Office Action, the Examiner has failed to provide Official Notice that was requested in the last Reply. While it is recognized that the MPEP does state a time for challenging the assertion of "Official Notice", the Examiner was requested to supply evidence of this assertion. See *In re Ahlert*, 424 Fed. 2d 1088, 165 USPQ, 418 (CCDA 1970) cited in the MPEP, for example in Section 2144.03e.

With respect to the time limit set in the MPEP for challenging Official Notice, the statement in the MPEP is merely a guideline and has no weight with respect to Rules, Statutes or court cases. Also, it is considered the Applicants have seasonably challenged the statement of Official Notice as the application is still before the Examiner and that there is no admission by the Applicants. See, *Fleming v. Giesa* (BdPatApp&Int) 13 USPQ2d 1052 (7/17/89) where it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, *Harner et al. v. Barron et al.*, 215 USPQ 743 (Comr Pats 1981), *Suh v. Hoefle* (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), *Issidorides v. Ley* (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and *Ex parte The Successor in Interest Of Robert S. McGaughey*

(BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988). These cases are legal precedent and are superior to what the guidelines are in the MPEP and by law must be followed by the Patent Office.

CONCLUSION

If the Examiner has any questions concerning this application, the Examiner is requested to contact Elliot A. Goldberg, Reg. No. 33,347 at the telephone number of (703) 205-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Dated: November 21, 2005

Respectfully submitted,

By 

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